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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Oshima, et. al.
Application No. 09/677,420
Filed: October 5, 2000
Attorney Docket No. 2000-1390

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DECISION GRANTING
PETITION UNDER
37 CFR §1.183

This is a decision on the June 4, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$130.00 has been charged to Deposit Account No. 23-0975 for the petition under 37 CFR 1.183, as authorized by the petition on page 1.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on November 12, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on November 12, 2003, is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

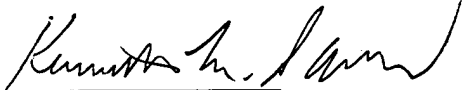
On November 12, 2003, a substitute specification was filed together with a Request for Reconsideration of an outstanding Office action. The reason for its submission was stated as "The Examiner required a substitute specification because of the length of the changes made in the Amendment filed April 24, 2003." It is noted on page 4 of the Office action mailed July 11, 2003 (paper No. 23) the examiner stated "A substitute specification is required pursuant to 37 CFR 1.125(a) because the length of the changes made could cause mistakes during the process of entering the amendments."

Petitioner is now requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that "In several of the applications, the Examiner required a substitute specification because of the length of the specification and the number of amendments, and indicated by telephone that substitute specifications would be required in all of the related reissue applications."¹

This basis is considered to be sufficient for granting the petition. The rule will be waived, since there is no other way to present the substitute specification required by the examiner, and that requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on November 12, 2003 is accepted, and will be entered.
3. The reissue application file is being forwarded to Technology Center 2600 for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Dwayne D. Bost, TC2600 SPRE, at (703) 305-4778.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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¹ No other record of the referenced telephone conversation can be found in this application file.